



Case Docket No.: SN-LM-025009

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: : Mail Stop Appeal Brief-Patents
Shuichi HIRAYAMA :
Serial No. 10/076,956 : Patent Art Unit: 3728
Filed: February 19, 2002 : Examiner: Anthony D. Stashick
For: BOOT LINER :
:

REPLY BRIEF

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Commissioner of Patents
United States Patent and Trademark Office
Alexandria, VA 22313-1450

Sir:

In response to the July 18, 2006 Examiner's Answer, Appellant submits this Reply Brief in accordance with 37 C.F.R. §41.41.

To begin with, Appellant apologizes for placing the wrong name of the inventor on the cover sheet of the Appeal Brief. If a new cover sheet for the Appeal Brief is needed, please contact the undersigned.

Basically, Appellant wishes to address several issues raised in the July 18, 2006 Examiner's Answer in this Reply Brief, as follows.

1. *New assertions with respect to U.S. Patent No. 6,012,236 to Pozzobon;*
2. *New assertions with respect to U.S. Patent No. 3,925,916 to Garbuio;*
3. *Clarifying the record in view of the Examiner's Answer; and*
4. *Discussion of the definition of the term "in" as used in the claims.*

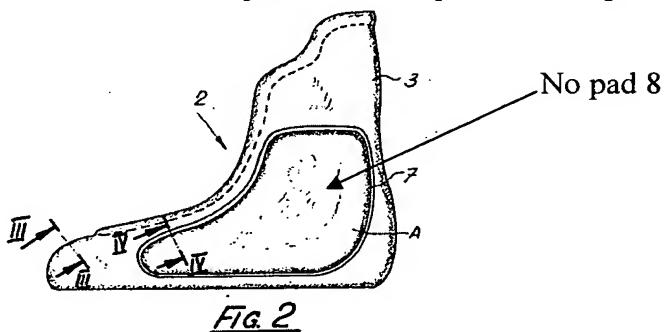
If there are any questions regarding this Brief, please feel free to contact the undersigned.

New assertions with respect to the Pozzobon patent

With respect to the Pozzobon patent, there appears to be a controversy as to whether the Pozzobon discloses a “boot” or not. At the top of page 6 of the Examiner’s Answer, the Examiner asserts for the first time that the Pozzobon patent discloses a boot. Specifically, the Examiner’s Answer states “[c]learly, in Figure 1 of Pozzobon, a boot is disclosed and shown.” Furthermore, throughout the Examiner’s Answer “the boot 1 of Pozzobon” is stated. However, a boot is *not* disclosed anywhere in the Figures or text of the Pozzobon patent. Rather, the Pozzobon patent discloses an “innerboot” *for* sport shoes that allows optimum ventilation of a foot (see, the abstract of the Pozzobon patent).

Whether or not the Pozzobon patent discloses a boot is not relevant to the issues of the present application. The real question is whether or not one of ordinary skill in the art would combine the teachings of the “innerboot” of the Pozzobon patent with the teachings of the Garbuio patent and teachings of the Clement et al patent in such a manner as to render the claims of the present application unpatentable.

This so called “boot” of the Pozzobon patent controversy does not depend on whether or not the Pozzobon patent discloses a boot. Appellant concedes that the “innerboot” of the Pozzobon patent could potentially be used with a boot. However, the important point to note is that the boot pads 8 of the Garbuio patent are not part of the inner liner or insert 2 of the Garbuio patent as clearly shown in Figure 2, which illustrates the liner 2 when the boot 1 has been removed. In other words, Figure 2 (reproduced below) of the Garbuio patent shows the inner liner or insert 2 by itself and the boot pads 8 are not present in Figure 2.



Thus, Appellant contends that the boot pads 8 of the Garbuio patent are part of the boot 1, and that the boot pads 8 of a boot would not be added to the inner boot of the Pozzobon patent without some kind of motivation. Stated differently, it is unclear why one of ordinary skill in the art would be motivated to take features of the *boot 1* of the Garbuio patent and apply the features to the *innerboot 1* of the Pozzobon patent.

Appellant further contends that if one of ordinary skill in the art would combine the teachings of the “innerboot” of the Pozzobon patent with the teachings of the “boot” of the Garbuio patent, then any hypothetical product resulting from this combination would merely have the boot pads 8 of the Garbuio patent as part of a boot, not part of an inner liner as claimed. The additional references (the Clement et al patent and the Breuner patent) do not disclose banana shaped pads as claimed, and thus, are irrelevant to the banana shaped pad limitations of the claims.

The Examiner’s Answer seems to further assert that the banana shaped pads of the claims are not required to be a part of the inner liner. Appellant contends that this is an improper interpretation of the claims. In particular, each of the claims recites a “boot liner” comprising a sole portion and an upper portion including first and second banana shaped pads. Clearly since the claims recite that the upper portion *includes* first and second banana shaped pads, a combination of references that result in a hypothetical boot and liner with the boot pads 8 being part of a boot is not relevant to the claims and do not render the claims unpatentable.

New assertions with respect to the Garbuio patent

With respect to the Garbuio patent, the Examiner has presented some new assertions that Appellant would like to briefly address. First, at page 6, lines 19-22 of the Examiner's Answer, the Examiner states

With respect to appellant's arguments that Pozzobon uses vapor-permeable material and not air-impervious material, the type of material used for the boot, whether it be vapor-permeable or air-impervious, does not affect the use of the pads 8 in the ankle area for protection and cushioning as this would occur no matter what material was used behind the pads.

The Examiner would appear to be erroneously suggesting that the type of insert is irrelevant when using the boot pads 8. The assertion that the boot pads 8 can be used with any type of insert appears to be a new interpretation of the Garbuio patent and contrary to the teachings of the Garbuio patent.

Appellant respectfully disagrees with this assertion. The Garbuio patent is specifically directed to a particular type of insert with a particular construction. There is no suggestion or motivation to use the boot pads 8 of the boot with any other type of liner or insert. To the contrary, the boot pads 8 of the Garbuio patent are specifically designed for use with the insert 2 of the Garbuio patent. In particular, as previously stated on page 12 of the Appellant's Appeal Brief, the Garbuio patent states at column 2, lines 35-38:

Any lateral pressure acting upon this pad [8] will be distributed by the resilient core 4a over the entire area A *for effective cushioning* of the foot without materially impeding its mobility. (Emphasis Added)

Therefore, in order to properly use the boot pads 8 of the Garbuio patent, the liner or insert should have the same or substantially the same construction as the air-impervious area A of the insert 2 of the Garbuio patent. Accordingly, providing the boot pad 8 and the air-impervious area A on the innerboot 1 of the Pozzobon patent would completely go against the original intent of the Pozzobon patent to achieve optimum ventilation of the foot.

The Examiner has asserted for the first time that the boot pads 8 of the Garbuio patent are made of the same material as the core 4a (see, page 8, lines 10 and 17 of the Examiner's Answer) in order to explain the thickness of the boot pads 8. Appellant respectfully asserts that the boot pads 8 of the Garbuio patent are *not* made of the same material as the core 4a. Referring to column 2, lines 30-34 of the Garbuio patent, the boot pads 8 are described as being of a material substantially denser than the core 4a. Moreover, the Garbuio patent states that the boot pads 8 may consist of the same material as the core portion 4 surrounding the area A.

Not only is this new assertion incorrect, but it does not show the claimed limitation of the first and second banana-shaped pads being thicker than the thermoformable layer of the Pozzobon patent. The thicknesses of the boot pads 8 relative to any layer of the insert 2 of the Garbuio patent are irrelevant. This relationship, if disclosed in the Garbuio patent, does not teach one of ordinary skill in the art what the relative thicknesses of the boot pads 8 of the Garbuio patent to the thickness of the thermoformable layer of the Pozzobon patent would be if they were somehow used with the inner boot 1 of the Pozzobon patent. In particular, the Examiner apparently relies on the Pozzobon patent to show the claimed features of the thermoformable layer, and then apparently attempts to show a relationship between the core 4a and the layer 3 of the Garbuio patent as a reason that the pads 8 would be thicker than the thermoformable layer of the Pozzobon patent. A step is clearly missing in this logic of the using the boot pads 8 of the Garbuio patent with the innerboot 1 of the Pozzobon patent to show a thickness relationship between first and second banana-shaped pads and a thermoformable layer when the hypothetical boot/liner is made from the combination of these patent without using the insert 2 of the Garbuio patent at all in the hypothetical boot/liner. How does the Examiner know that the thickness of any layer in the Garbuio patent is more or less than a thickness of a layer in the Pozzobon patent? In other words, absent specific

dimensions in the references, there is no *prima facie* case of obviousness that any layer or boot pad 8 of the Garbuio patent is thicker than the thermoformable layer in the Pozzobon patent.

Nevertheless, as argued on page 16 of Appellant's Appeal Brief, the Examiner's argument that the boot pads 8 have the same thickness as another layer because the boot pads 8 are of the same material as another layer *is erroneous*. Just because the boot pads 8 may be of the same material as another layer, does *not* necessarily mean that the boot pads 8 are made with the same thickness as that layer. The boot pad 8 could be made of any thickness from the same material. The type of material does not govern thickness.

Clarifying the record in view of the Examiner's Answer

With respect to some of the assertions made in the Examiner's Answer, Appellant would like to clarify the record. At page 8, lines 7-9 of the Examiner's Answer, the Examiner states that

Appellant argues that the thickness of pads 8 in Garbuio has not been discussed or illustrated. This limitation was discussed in the rejection set forth in the Final Office Action and above in paragraph 2 of the rejections section.

Appellant never argued that the thickness of the boot pads 8 in the Garbuio patent has not been discussed or illustrated by the Examiner. *Indeed, Appellant quoted the Examiner's discussion of the thickness* at the top of page 16 in the Appeal Brief. Rather, Appellant was merely arguing that the thickness of the pads 8 in the Garbuio patent is *not* discussed or illustrated *in* the Garbuio patent. In the last paragraph at the bottom of page 15 in Appellant's Appeal Brief, Appellant stated

In the Pozzobon, Garbuio and Clement et al combination rejection, the Garbuio patent is relied on to teach the first and second banana-shaped pads. However, the thickness of the pads 8 in the Garbuio patent is not discussed or illustrated. The Pozzobon and Clement et al patents do not remedy the deficiency of the Garbuio patent.

Thus, Appellant argues that the Examiner has designated the pads 8 as the first and second banana-shaped pads yet nowhere *in* the Garbuio patent are the thicknesses of the pads 8 discussed or illustrated. The Pozzobon and Clement et al patents do not remedy this deficiency.

At page 8, lines 17 and 18 of the Examiner's Answer, the Examiner states that the Examiner "did not propose placing layer 3 of Garbuio in the boot of Pozzobon as inferred." Appellant never meant to infer that the Examiner proposed placing layer 3 of the Garbuio patent in the boot of the Pozzobon patent. Rather, the rejection was unclear to Appellant. As now understood, Appellant objects to relying on the teachings of the insert 2 of the Garbuio patent to interpret the thickness of the thermoformable layer of the Pozzobon patent when the insert 2 of the Garbuio patent is not being used in the combination of these references. In particular, as stated on page 16 of Appellant's Appeal Brief, Appellant was pointing out that the rejection relies on the Pozzobon patent to show the claimed features of the thermoformable layer then relies on the Garbuio patent as disclosing the rest of the claimed features of the thermoformable layer.

Referring to page 4, lines 16-20 of the Examiner's Answer, in addressing the claimed limitation of the first and second banana-shaped pads being thicker than the thermoformable layer, the Examiner continues to use the thickness of the thermoformable layer 3 of the Garbuio patent to show the claimed thickness limitation while using the thermoformable layer of the Pozzobon patent to show the claimed thermoformable layer limitation. As discussed above, clearly, there is a missing step showing how one of ordinary skill in the art would know that the thickness of any layer in the Garbuio patent is more or less than a layer in the Pozzobon patent.

Discussion of the definition of “in”

At page 8, lines 20-24 of the Examiner’s Answer, the Examiner states that even though the Garbuio patent discloses the boot pad 8 of the *boot I* (not the liner 2) as *exteriorly adjacent* to the liner 2, the Garbuio patent is considered as disclosing Appellant’s claimed *boot liner* having the first banana-shaped pad located *in* the outer side of the ankle section and the second banana-shaped pad located *in* the inner side of the ankle section. In particular, the Examiner has indicated that the word “*in*” as used in¹ the claims does not mean “a part of” the boot liner of the claim. The Examiner has apparently interpreted the word “*in*” as meaning something that is merely adjacent or in the vicinity of the boot liner. Appellant believes that this is an improper claim construction of the word “*in*” as used in the context of the specification and the claims.

The Examiner has not rejected the claims as being indefinite under 35 U.S.C. §112, 2nd paragraph for the use of the word “*in*”. Therefore, the language is considered proper and should be given its meaning within the scope of the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). The Federal Circuit in *Phillips* stated that a dictionary definition cannot be arbitrarily chosen in interpreting the claims. The Federal Circuit found in *Phillips* that dictionary definitions focus on the abstract meaning of words rather than on the meaning of the claim term to the artisan within the context of the specification. Thus, according to *Phillips*, the meaning of “*in*” should be determined from the context of the specification and the claims.

First, each of the claims recites a “boot liner” comprising a sole portion and an upper portion including first and second banana shaped pads. Thus, the claims by themselves clearly indicate that the meaning of “*in*” should be construed as the first and second banana shaped pads being part of the boot liner. Clearly since the claims recite that the upper portion *includes* first and second banana shaped pads, a combination of references that result in a hypothetical boot and liner with the boot pads 8 being part of a boot is not relevant to the

¹ The word “*in*” as used here means a “part of” the claims not merely adjacent to the claims.

claims and do not render the claims unpatentable. In other words, pads located on a boot are not "in" a boot liner as required from the plain reading of the claims.

Second, with respect to the specification, the word "in" is not used to mean "exteriorly adjacent" to the boot liner. For example, referring to page 7, lines 15-22 of Appellant's specification, it states that the first and second non-thermoformable members 29 form a pair of banana-shaped or L-shaped bulges B that extend laterally towards each other. The specification further states that the non-thermoformable members 29 are located *in* the inner and outer sides of the ankle section 21. Referring to Figures 3, 5 and 6, the specification further states that the first and second non-thermoformable members 29 are preferably located between the thermoformable layer 28b and the inner spongy layer 28c. Thus, the first and second non-thermoformable members 29 forming the first and second banana-shaped pads are illustrated and described as *in* the inner and outer sections of the boot liner and *not exteriorly adjacent* to the inner and outer sections of the boot liner. In other words, the word "in" is not used to mean "exteriorly adjacent" to the boot liner in the specification or in the claims, and thus, such an interpretation is improper.

Conclusion

In view of the above arguments and in further view of the arguments of the April 24, 2006 Appeal Brief, Appellant respectfully requests that the rejections of claims 6-13 and 15-28 be reversed.

Respectfully submitted,


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